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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/815,636	03/23/2001	Thomas P. Hicks	SEI0001.US	4629

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EXAMINER

CHAMPAGNE, DONALD

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/815,636

Applicant(s)

HICKS ET AL.

Examiner

Donald L. Champagne

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. At the last two lines, "remote from both the business establishment location" is indefinite.

### *Claim Rejections - 35 USC § 102 and 35 USC § 103*

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 4, 6-11, 13-17 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Hendricks et al. (US005734853A).
6. Hendricks et al. teaches (independent claims 1, 13 and 16) a method of displaying advertising messages in juxtaposition with program information, of displaying locally stored information as part of a received television transmission, and of appending a message to program information, comprising the steps of: introducing a *program overlay menu 1390* (col. 26 lines 30-44 and col. 14 lines 5-11) containing promotional material (col. 18 line 52 to col. 19 line 6), which reads on an advertising

Art Unit: 3622

message, over programming being watched, which also reads on modifying the program information to occupy less than the entire visible portion of the display device thereby creating an open region, and introducing an advertising message in to the open region; and periodically changing the advertising message independently of the displayed program information (col. 18 lines 52-57). Hendricks et al. also teaches (claim 13) demodulation (col. 19 line 11) and locally stored information (col. 11 lines 39-49).

7. Weight of preamble - The preamble statements concerning "a business establishment" in claims 1 and 16 were not given patentable weight because these statements only state intended use, and do not limit the structure of the claimed invention (MPEP § 2111.02).
8. Hendricks et al. teaches at the citations given above claims 3, 4, 7, 9, 11, 17 and 19. Hendricks et al. also teaches claim 6 (col. 26 lines 23-24) and claims 8, 14 and 15 (col. 7 lines 14-25).
9. Hendricks et al. does not explicitly teach (claim 10) that the programming and advertising information are respectively stored in and played from distinct storage devices. However, under the principles of inherency (MPEP § 2112.02), since the reference invention necessarily performs the method claimed, the method claimed is considered to be anticipated by the reference invention. As evidence tending to show inherency, it is noted the various components of the signals, notably the graphics portion used to form the program menus and the video portion used to form the advertising message, must be stored separately, which reads on in distinct storage devices.
10. Claims 2, 5, 12 and 18 are rejected under 35 U.S.C. 103(a) as being obvious over Hendricks et al.
11. Hendricks et al. does not teach (claim 2) that the open region comprises about 15%. Such a parameter is commonly determined by routine experiment (MPEP § 2144.05.II.A). The process of routine experiment is obvious to one of ordinary skill in the art.
12. Hendricks et al. does not teach (claims 5, 12 and 18) the distribution of advertising revenue. Because the system could operate only if the distributors of advertising

Art Unit: 3622

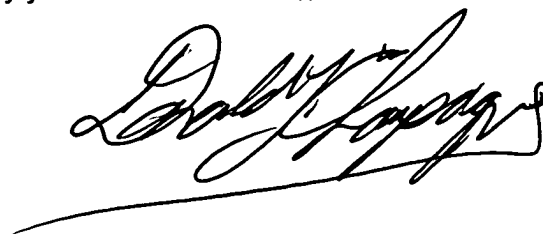
were paid, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Hendricks et al. that agreements for the distribution of advertising revenue be initiated and executed in accordance with common practice.

13. Hendricks et al. does not teach that separate entities own the remote advertising source and the places where the advertising is displayed. This ownership limitation is nonfunctional descriptive material, and was accordingly not given patentable weight (MPEP 2106.IV.B.1(b) at pp. 2100-13 and 2100-14 revised May 2004).

### ***Conclusion***

14. Any inquiry concerning this communication should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at [donald.champagne@uspto.gov](mailto:donald.champagne@uspto.gov), and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 703-746-5536.
15. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-5771.
16. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, [www.uspto.gov](http://www.uspto.gov). At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

4 August 2004



Donald L. Champagne  
Primary Examiner  
Art Unit 3622